

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicants: Richard A. Wilsak et al.)
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Confirmation No.: 2288)
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Application No.: 10/663,918)
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Filed: September 16, 2003)
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Title: SOLID-LIQUID SEPARATION)
PROCESS)
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Group Art Unit: 1724)
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Examiner: Robert J. Popovics)
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Attorney Docket No.: 37,512)

RESPONSE TO OFFICE ACTION

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the office action mailed December 23, 2009, the applicants submit the following remarks:

Claims 1, 2, 5-16, 40, 41, 44, 45, 48, and 49 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement.

The Examiner alleges that the specification fails to teach those skilled in the art how a displacement fluid causes displacement of a liquid from a slurry feed. Referring to FIG.1, the Examiner states that fluid entering nozzle 29 would follow the path of least resistance towards open chute 33.

The Examiner is correct to assume the displacement fluid entering nozzle 29 proceeds towards chute 33. However, the displacement fluid also "initially

enters the open end 15 of the cylinder [11]" during start-up. See specification, page 15, line 13.

The specification also clearly teaches how displacement fluid is used to displace liquid from a slurry feed. As stated on page 11, lines 20-23 of the specification:

[T]he highest imparted pressure is generally at the slurry feed inlet, the lowest imparted pressure is generally at one or more filters of the filter column at the interior of one or more filter tubes, and the pressure at the product chute is at an intermediate level. Since fluids flow in the direction of high pressure to low pressure, this ensures that the fluids in the filter column move towards the filters. (emphasis added).

Furthermore, the Example described on pages 17-20, illustrates the pressure differences. The specification states that "nitrogen [the displacement fluid] entering the filter column was 65 psia at end of run (page 17, line 23, emphasis added)," which is higher than the "pressure of the interior of the filter tubes [which] throughout the run averaged 14.7 psia. (page 18, lines 6-7)."

It is submitted that one skilled in the art would be able to make and use the invention based on the teachings of the specification. To the extent the Examiner may be focusing on pressure control at the open end 33, the applicants respectfully submit that those skilled in the art, such as chemical engineers, would readily recognize both the need for and identity of appropriate pressure controls, such as valves and the like. The nature of the pressure control mechanism is dependant on a variety of factors, including downstream processing steps. For example, further downstream separation may be necessary where the flush feed entering inlet 31 is used. The specific mechanism for controlling pressure at open end 33 is beyond the scope of the invention. "[A] patent need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986). Accordingly, the applicants respectfully request that the rejection be withdrawn.

Claims 1, 2, 5-16, 40, 41, 44, 45, 48, and 49 were rejected under 35 U.S.C. § 112, 1st paragraph, for failing to disclose the best mode contemplated by the inventor.

The Examiner states that a comparison FIG. 1 of the present application to FIG. 3 of the US 2007/022539 evidences concealment of the best mode and that "something is missing".

The applicants respectfully submit that the Examiner has failed to establish a prima facie case of concealment of the best mode. As an initial

matter, the referenced '539 patent application was filed over two and one-half years after the present application, so the '539 application cannot be used to determine the mental state of the inventors at the time of filing of the present application. Furthermore, the Examiner has failed to provide any analysis of why the FIG of the '539 application was allegedly the inventors' best mode.

Accordingly, the applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, the applicants respectfully submit that the claims are in condition for allowance. Should the Examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the Examiner is urged to contact the undersigned attorney.

Respectfully submitted,

BP AMERICA INC.

3/23, 2009



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